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DEC 20 2010

OFFICE OF PETITIONS

In re Application of	:	
Anne D. Frame	:	DECISION ON APPLICATION
Application No. 10/500,098	:	FOR PATENT TERM ADJUSTMENT
Filed: June 24, 2004	:	
Attorney Docket No. 083622.00003	:	

This is a decision responding to the "Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. §1.705" filed August 27, 2010. Applicant requests the initial determination of patent term adjustment be corrected from zero (0) days to one hundred sixteen (116) days.

The application for patent term adjustment is **dismissed**.

The Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) on May 27, 2010, advising Applicant of a patent term adjustment to date of 0 days. In response, Applicant timely filed this application for patent term adjustment with payment of the issue fee on August 27, 2010.

Applicant disputes the Office's calculation of the total period of delay under 37 C.F.R. § 1.704 ("Applicant Delay"). Specifically, Applicant objects to the Office's entry of:

1. A 15-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8),
2. A 29-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b),
3. A 59-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b), and
4. A 91-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8).

The 15-Day Reduction in Patent Term Adjustment Under 37 C.F.R. § 1.704(c)(8)

The Office issued a non-final Office action on March 25, 2008.

Applicant filed a reply on June 24, 2008.

Applicant filed a second reply in the form of an amendment on July 9, 2008, in order to correct Applicant's failure to show the term "cobaltacene-octomet" was deleted and to indicate the term "cobaltocene-octomethyl" was being added in Table 5 of Exhibit 2 filed June 24, 2008

The Office issued a non-final Office action on July 22, 2008.

The Office entered a 15-day reduction in patent term adjustment as a result of Applicant filing the July 9, 2008 amendment, 15 days after filing a prior reply to the March 25, 2008 Office action.

Applicant states the July 22, 2008 Office action did not address the changes made in the July 9, 2008 amendment and states the Office did not issue a supplemental Office action addressing the changes. Applicant then states, "Thus, under 37 C.F.R. 1.704, paragraph 6, this is not a delay for which the Applicant has to pay in patent term adjustment."

The Office agrees the previously cited facts do not warrant a reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(6). However, the Office entered the 15-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8), not 37 C.F.R. § 1.704(c)(6).

Pursuant to 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

The July 9, 2008 amendment was filed after Applicant had already filed a reply to the March 25, 2008 Office action and the record fails to indicate the examiner expressly requested the submission of the July 9, 2008 amendment. Therefore, the previously discussed facts warrant entry of a reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8).

Applicant asserts, if a reduction is warranted, the reduction should be 14 days instead of 15 days because any period of reduction should begin on the day after the date the initial reply was filed. Applicant's assertion would be correct if the supplemental reply had been filed on July 8, 2008 as stated in the petition. However, the supplemental reply was actually filed on July 9, 2008. The number of days beginning June 25, 2008, the day after the initial reply was filed, and ending on July 9, 2008, the date the supplemental amendment was filed, is 15 days. Therefore, the 15-day reduction in patent term adjustment was proper.

The 29-Day Reduction in Patent Term Adjustment Under 37 C.F.R. § 1.704(b)

Applicant objects to a 29-day reduction in patent term adjustment entered by the Office. Applicant states,

The Office mailed a Non-Final rejection on July 22, 2008 [and] Applicant timely filed a response on September 9, 2008. However, the Patent Term Adjustment History ... incorrectly [uses the language] Amendment Crossed in Mail [to refer to the response] presumably in reference to the Final Rejection issued on September 30, 2008.... The

USPTO Patent Term Adjustment History starts counting [a period of Applicant delay] on September 30, 2008 when the Final rejection was mailed.

Applicant appears to misunderstand the Office's factual and legal basis for entering the 29-day reduction in patent term adjustment.

The 29-day reduction in patent term adjustment was based on the following facts:

1. The Office mailed a final Office action on September 30, 2008; and
2. A proper reply to the final Office action was not filed until January 28, 2009.

The 29-day reduction in patent term adjustment was based on 37 C.F.R. § 1.704(b), which states,

[A]n applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

The number of days beginning December 31, 2008, the day after the date three months after the date the Office mailed the final Office action, and ending on January 28, 2009, is 29 days. Therefore, the entry of a 29-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b) was proper.

The 59-Day Reduction in Patent Term Adjustment Under 37 C.F.R. § 1.704(b)

The Office issued a non-final Office action on April 14, 2009.

Applicant filed a response on September 11, 2009.

The Office entered a 59-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b) based on the preceding facts.

Applicant asserts the Office should have entered a 58-day reduction.

The period of reduction in patent term adjustment under 37 C.F.R. § 1.704(b) is the number of days beginning on the day after the date that is three months after the date the Office issued the rejection or Office action and ending on the date a reply is filed.

The number of days beginning July 15, 2009, the day after the date three months after the Office mailed the final Office action, and ending on September 11, 2009, the date a reply was filed in

response to the Office action, is 59 days. Therefore, the entry of a 59-day, rather than a 58-day, reduction in patent term adjustment was proper.

The 91-day Reduction in Patent Term Adjustment Under 37 C.F.R. § 1.704(c)(8)

The Office entered a 91-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8) as a result of Applicant filing an IDS on April 16, 2010, 91 days after filing a response to a Notice of Non-Compliant Amendment on January 15, 2010.

Applicant argues the 91-day reduction in patent term adjustment is improper based on an assertion the IDS was filed in a manner which excludes it from counting as delay “under 37 C.F.R. 1.704, paragraph 11.”

Applicant appears to misunderstand the Office’s basis for entry of the 91-day reduction in patent term adjustment.

Pursuant to 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

37 C.F.R. § 1.704(d) states,

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

The 91-day reduction in patent term adjustment was entered pursuant to 37 C.F.R. § 1.704(c)(8). The record fails to indicate the IDS was expressly requested examiner and the IDS was not accompanied by a statement under 37 C.F.R. § 1.704(d). Therefore, the Office’s entry of a 91-day reduction in patent term adjustment for the IDS filed April 16, 2010, 91 days was proper.

Conclusion

Applicant has failed to establish the Office acted improperly when the Office entered:

1. A 15-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8),

2. A 29-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b),
3. A 59-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b), and
4. A 91-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8).

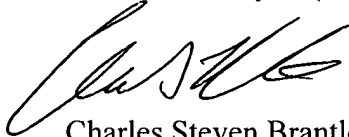
As of the mailing of the notice of allowance, the total period of Office delay (363 days) was less than the total period of Applicant Delay (364 days). The Office does not set forth negative balances of patent term adjustment when notifying applicants of the Office's calculation of the initial patent term adjustment. Therefore, the initial patent term adjustment of 0 days mailed with the notice of allowance was proper.

Submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fee is required.

Applicants is reminded any Office delays pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b), and any Applicant delays under 37 C.F.R. § 1.704(c)(10), will be calculated at the time of the issuance of the patent and Applicant will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



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